

REMARKS

I. General

The issues raised by the present Office Action are as follows:

- Claims 1, 3-8, 10, 12-16, 19-27, 35, 36, 39, 40 and 42-46 stand rejected under 35 U.S.C. §103(a) as unpatentable over Takayama, U.S. Pat. No. 6,674,596 (hereinafter, *Takayama*), in view of Kato, et al., U.S. Pat. No. 6,611,394 (hereinafter, *Kato*);
- Claims 2, 11 and 38 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama*, in view of *Kato*, and further in view of Morita, U.S. Pat. No. 5,612,827 (hereinafter *Morita*);
- Claims 9, 17, 32 and 33 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama*, in view of *Kato*, and further in view of Amamiya, Japanese Patent Application Publication Number 2000-295507 (hereinafter *Amamiya*);
- Claim 30 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama*, in view of *Kato*, as modified by *Amamiya*, and further in view of Kita, U.S. Pat. No. 5,199,593 (hereinafter *Kita*); and
- Claim 31 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama*, in view of *Kato*, as modified by *Amamiya*, and further in view of Heigl, U.S. Pat. No. 4,746,796 (hereinafter *Heigl*).

Applicant respectfully traverses these rejections and requests withdrawal of same in light of the remarks presented below. Claims 1-17, 19-27, 30-33, 35, 36, 38-40 and 42-46 remain pending in the present application.

II. Rejections of the claims under 35 U.S.C. §103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P.

§2143. Without conceding the second criteria, Applicant asserts that the rejections do not satisfy the first and third criteria.

A. The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that *Takayama* does not teach a length of magnetic tape medium using a write density differing from standard type tape media. The Office Action attempts to cure this deficiency by introducing *Kato*. The Office Action alleges that:

it is disclosed by Kato et al that different tape formats may differ in write density as well as track pitch (column 28, lines 32-36). A tape drive that does not support or recognize a specific write density will not be capable of reproducing or modifying data recorded on a tape that has been recorded in said specific write density. Therefore it is considered well known in the art that data recorded on a tape may be recorded at different densities in order to record data in a different format. (See Page 3 of the Office Action.)

First, in light of the latter two sentences of the above recited Office Action text, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Under Rule 37 C.F.R. §1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. §2144.03, the Examiner is hereby requested to cite a reference in support of the assertion, and/or explain how *Kato* supports this assertion. Otherwise the rejection of claims 1-17, 19-27, 30-33, 35, 36, 38-40 and 42-46 should be withdrawn.

Regardless, the combination of *Takayama* and *Kato* does not teach or suggest all limitations of the claimed invention as relied upon by the Office Action.

Independent claims 1 and 9 recite “a length of magnetic tape adapted to record and store electronic data using a write density differing from standard type tapes.” Independent claim 10 recites “a length of magnetic tape medium is capable of storing electronic data using a write density differing from standard type tape media.” Independent claim 17 recites “a length of magnetic tape medium is capable of storing electronic data, using a write density differing from standard type tapes.” Independent claim 19 recites “a length of magnetic tape

medium capable of storing electronic data using a write density differing from standard type tape media.” Claim 35 recites “a length of magnetic tape adapted to record and store electronic data using a write density differing from standard tapes of a same format.” Finally, independent claim 42 recites “means for identifying a write density of a tape medium operatively housed in said tape cartridge differing from standard tape media of a same format.” Contrary to the position of the Office Action, *Kato* does not disclose these limitations.

The portion of *Kato* cited by the Office Action, column 28, lines 32-36, states:

The AIT-1 and AIT-2 formats are different from each other in recording density with which data is written to the magnetic tape. It is standardized that the AIT-2 format being a higher-order format should be higher in recording density than the AIT-1 format.

Further, as taught at least at column 14, line 50 through column 15, line 30; column 17, lines 31 and 32; and column 24, lines 3 and 4, and lines 16-20; AIT-1 and AIT-2 are standardized tape formats. Further, the AIT Tape Forum frequently asked questions section indicates:

AIT formats have been standardized by the European Computer Manufacturers Association (ECMA) and ECMA has submitted these standards to the International Organization for Standardization (ISO) and ISO registration. (Please see: http://www.aittape.com/ait-faq.html#Q2_GENERAL.)

Thus, without conceding that the cited references teach all of the other elements alleged by the Office Action, Applicant respectfully contends that *Kato* does not teach or suggest the claim element “a length of magnetic tape adapted to record and store electronic data using a write density differing from standard type tapes” (emphasis added) as recited by claims 1 and 9, or the other above recited elements of claims 10, 17, 19, 35 or 42. Indeed, Applicant would respectfully assert that, whereas *Kato* teaches the use of a write density conforming to the AIM-1 or AIM-2 standard, one might view *Kato* as teaching away from these above recited elements of the independent claims.

In addressing independent claims 9 and 17, the Office Action does not rely on *Amamiya*, as disclosing the above recited elements of claims 9 and 17. Regardless, *Amamiya* does not teach “a length of magnetic tape adapted to record and store electronic data using a write density differing from standard type tapes,” as recited by claim 9, or “a length of magnetic tape medium is capable of storing electronic data, using a write density differing from standard type tapes, said magnetic tape medium,” as recited by claim 17.

Further, as noted above claim 35 recites “a length of magnetic tape adapted to record and store electronic data using a write density differing from standard tapes of a same format” and independent claim 42 recites “means for identifying a write density of a tape medium operatively housed in said tape cartridge differing from standard tape media of a same format.” (emphasis added). It would seem that the disclosure of *Kato* not only fails to teach or suggest these elements as discussed above, *Kato* teaches away from these elements, particularly the emphasized portions.

Therefore, Applicant respectfully asserts that for at least the above reasons independent claims 1, 9, 10, 17, 19, 35 and 42 are patentable over the 35 U.S.C. §103(a) rejection of record.

Claims 2-8 depend directly or indirectly from independent claim 1, claims 11-16 depend directly from independent claim 10, claims 20-27 depend directly from independent claim 19, claims 30-33 depend directly from independent claim 17, claims 36, 38-40 depend directly from independent claim 35, and claims 43-46 depend directly from independent claim 42. Thereby, each of claims 2-8, 11-16, 20-27, 36, 38-40 and 43-46 inherit all limitations of their respective independent base claims 1, 10, 19, 17, 35 and 42. Therefore, for at least the reasons advanced above in addressing the obviousness rejections of independent claims 1, 10, 19, 17, 35 and 42, each of claims 2-8, 11-16, 20-27, 36, 38-40 and 43-46 set forth features and limitations not recited by the combination of *Takayama* and *Kato*. Thus, Applicant respectfully asserts that claims 2-8, 11-16, 20-27, 36, 38-40 and 43-46 are also patentable over the 35 U.S.C. § 103(a) rejections of record.

Additionally, the present rejection of claim 23 is inconsistent with the previous rejection of this claim. The January 2, 2004 Office Action admits that *Takayama* fails to teach claim 23 element “ejecting said tape cartridge from said tape drive in response to said

tape drive being unable to read said write once read many tape type” (and similar elements of claims 2, 11 and 38). This rejection is affirmed in the June 14, 2004 Final Office Action. Additionally, in addressing claims 2, 11 and 38 the present Office Action admits that the combination of *Takayama* and *Kato* fails “to show the drive ejecting the cartridge in response to the drive being unable to recognize the information from the memory device.” However, in the present Office Action the combination of *Takayama* and *Kato*, alone, is relied upon in addressing claim 23. Therefore, Applicant requests that the Examiner clearly set forth the grounds for rejection with respect to claim 23, in a non-final Office Action, so that Applicant may have a full and fair opportunity to explore the patentability of this claim.

The Office Action does not provide the requisite motivation.

As discussed above, the Office Action admits that *Takayama* does not teach a length of magnetic tape medium using a write density differing from standard type tape media. The Office Action attempts to cure this deficiency by introducing *Kato*, alleging that *Kato* teaches such a limitation. The motivation for making the combination was presented as follows:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a magnetic tape medium with differing write density since it is considered well known in the art and disclosed by *Kato et al.*
(See Page 3 of the Office Action.)

It is well settled that the mere fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. Language such as the motivation provided by the Office Action is at best a mere statement that the references can be combined, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Office Action is improper and insufficient, as the motivation must establish the desirability for making the combination. No valid suggestion has been made as to why a combination of *Takayama* and *Kato* is desirable. Whereas all the rejections in the present Office Action are based on the combination of *Takayama* and *Kato*, the rejections of claims 1-17, 19-27, 30-33, 35, 36, 38-40 and 42-46 should be withdrawn.

III. Conclusion

For at least the reasons given above, Applicant submits that the pending claims distinguish over the prior art under 35 U.S.C. §103. Accordingly, Applicant submits that this application is in full condition for allowance.

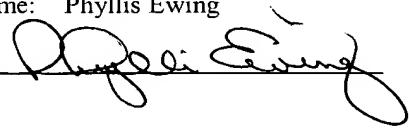
Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10011666-1 from which the undersigned is authorized to draw.

The Examiner is respectfully invited to call the below listed attorney if he can be of any assistance in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 482745137US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: January 5, 2005

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